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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/808,335

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Takuya Iwanami

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EXAMINER

FAISON GEE, VERONICA FAYE

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,335

Applicant(s)

IWANAMI ET AL.

Examiner

Veronica Faison-Gee

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preamble

The preamble limitation "used for color reproduction through subtractive color mixing" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 USPQ 6411.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 03/038001.

WO 03/038001 teaches an ink set composition comprising a plurality of inks of a first and of a second group. The first group comprises a visible colorant and an additional IR-absorbing compound, which has an absorption peak at a predetermined wavelength in the near infrared (abstract and page 4 lines 23-25). The reference further teaches a four-color ink set wherein an IR-absorbing taggants into IR-transparent black, yellow and magenta inks to yield the first group and by choosing an appropriate colorant (pigment or dye) for the cyan ink (page 5 lines 23-30). The composition as taught by WO 03/038001 appears to anticipate the claimed invention.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Hakamada et al (US Patent 6,835,239).

Hakamada et al teach a fluorescent ink comprising at least a coloring material and an aqueous medium, wherein the coloring material comprises Acid Red 52 (fluorescent dye) and at least one direct dye (col. 5 line 17-col. 6 line 56). See example I-2. The composition as taught by Hakamada et al appears to anticipate the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/038001.

WO 03/08001 fails to specifically exemplify a second coloring agent identical in hue to the first coloring agent. When general conditions (hue of colorant) are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by changing the size, shape, proportion of shape, degree and sequence of added ingredients through routine experimentation. (In re Rose, 105 USPQ 137; In re Aller 220F, 2d 454, 105 USPQ 233,235 (CCPA 1955); In re Dailey et al., 149 USPQ 47; In re Reese, 129 USPQ 402; In re Gibson, 45 USPQ 230).

Art Unit: 1755

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/038001 or Hakamada et al (US Patent 6,835,239).

WO 03/038001 and Hakamada et al (US Patent 6,835,239) are described above, but fails to specifically exemplify the formulas set forth in claims 3 and 4 as claimed by applicant.

WO 03/038001 and Hakamada et al (US Patent 6,835,239) and the claims differ in that WO 03/038001 and Hakamada et al (US Patent 6,835,239) does not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by WO 03/038001 and Hakamada et al (US Patent 6,835,239) overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05, absence evidence to the contrary.

Response to Arguments

Applicant's arguments, see page 4-5 with respect to Auslander, filed 3-20-06, with respect to claim 1 have been fully considered and are persuasive. The rejection of claim 1 has been withdrawn.

Applicant's arguments filed 3-20-06 have been fully considered but they are not persuasive. Applicant argues that Hakamada does not teach that the first and second colorants are identical in hue. The Examiner disagrees with Applicant. In the examples, the reference discloses that the first and second colorant may be the same hue.

Applicant's arguments with respect to claims 1 and 2 with respect to WO 03/038001 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica Faison-Gee whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

vfg
5-30-06


J. A. LORENGO
SUPERVISORY PATENT EXAMINER